REMARKS/ARGUMENTS

Claims 1-8, 10-13 and 16-19 are active in this application, claims 9 and 14-15 having been cancelled by the present amendment. The specification has been amended to address the trademark issue and the "weight average" molecular weight issue in paragraphs 2 and 3 of the Official Action. Claim 10 has been amended to correct the typographical error noted by the Examiner. Claims 1 and 11 have been amended to specify that the toner particles have a spindle shape. This amendment is supported by original claim 9. Claim 12 has also been amended to specify that the method is for preparing the toner of claim 11. Accordingly, if claim 11 is allowable over the art, Claim 12 is also allowable. Claim 13 has been amended to specify that the developer is a two-component developer comprising the toner and a carrier. This amendment is supported by original claim 14 and the specification. Claims 17 and 19 have been amended to specifically require the presence of the toner of claim 1 and developer of claim 13, respectively (although it is Applicants position that the claims as originally presented already required this to be the case by the term "configured", the claims have been amended to more explicitly state so). No new matter has been added by these amendments.

The present amendment addresses and obviates the various informalities raised by the Examiner in paragraphs 2-5 of the Official Action.

The present invention relates to a dry toner comprising:

a binder resin comprising a modified polyester (i); and

a colorant comprising a carbon black, wherein the carbon black has a pH not greater than 7,

wherein the toner has a volume average particle diameter (Dv) of from 3 to 7 μm and a ratio (Dv/Dp) of the volume average particle diameter (Dv) to a number average particle diameter (Dp) of from 1.00 to 1.25, wherein the toner has a spindle shape.

The toner may preferably be prepared by a method comprising

(A) dissolving or dispersing a toner composition in an organic solvent to prepare a toner composition liquid; and

(B) dispersing the toner composition liquid in an aqueous liquid, wherein the toner composition comprises the components noted above. The present invention further relates to the use of this dry toner in the preparation of toner developers (either one or two component) as well as an image forming apparatus and a toner cartridge having the toner therein.

The rejections under 35 U.S.C. 102/103

Claims 1-5, 8, 11-16, 18 and 19 stand rejected under 35 U.S.C. 102 or 103 over Matsuda, as evidenced by Bando. Claims 1-8, 11-16, 18 and 19 stand rejected under 35 U.S.C. 102 or 103 over Yagi, as evidenced by Bando. Claims 1-7, 11 and 13-15 stand rejected under 35 U.S.C. 103 over Nakanishi, combined with Ishiyama and Kawase. Claims 16-19 stand rejected under 35 U.S.C. 103 over Ohkubo, combined with Nakanishi, Kawase and Ishiyama. None of the references in these rejections, either alone or in combination, disclose or suggest the spindle shaped toner particles of the present invention (as noted by the rejections not including original claim 9, the limitations of which have now been added into original claims 1 and 11). All claims of the present application now require the toner particles to be spindle shaped, in addition to the other required characteristics set forth in the independent claims. Accordingly, with the inclusion in the claims of this limitation, each of these rejections has now been overcome, as the references cannot suggest the present invention as now claimed.

Claims 1-19 stand rejected under 35 U.S.C. 102(e) over Tomita, as evidenced by Bando. Applicants note that Tomita has an effective US filing date of November 14, 2003. Applicants provide herewith a Certified Translation of the Japanese priority document of the present application, having a priority date of November 29, 2002. Accordingly, Applicants having perfected their claim to priority, the present application is entitled to an effective date of November 29, 2002, prior to the effective prior art date of Tomita. As such, this rejection has been obviated and should be withdrawn.

Claims 17 and 19 stand rejected under 35 U.S.C. 102(b) over Ohkubo. The basis for the Examiner's rejection is that the claims as originally presented did not require the presence of the particular toner of the present invention. This has been remedied by the present amendment. Accordingly, since Ohkubo neither discloses nor suggests the present toner, a developer containing the toner, or its use in an image forming apparatus, the rejection has been obviated and should be withdrawn.

Claim 12 stands rejected under 35 U.S.C. 102(b) over Nakanishi. This rejection has been obviated by amending the claim to specify that the method is a method for preparing the toner of claim 11. Since upon entry of this amendment and the accompanying papers, there will be no remaining rejections for claim 1 or claim 11, Claim 12 will be allowable as a method for producing the toner of claim 11 (an allowable claim). Accordingly, the rejection should be withdrawn.

The Obviousness type Double Patenting Rejections

Claims 1-5, 11-16 and 18 stand rejected for obviousness type double patenting over claims 1-23 of Yagi, in view of JP '403. Claims 1-8, 11, 13 and 15 stand rejected for obviousness type double patenting over claims 1-8 of Tomita, in view of JP '403. Claims 1-4, 9, 11, 13-16 and 18 stand rejected for obviousness type double patenting over Claims 1-16 of Emoto '462, in view of JP '403. Claims 1-4, 11, 13-16 and 19 stand rejected for obviousness type double patenting over Emoto '945, in view of JP '403. Claims 1-5, 9-11, 13, 15, 16, 18 and 19 stand provisionally rejected for obviousness type double patenting over claims 1-25 of copending application 10/712,026, in view of JP '403.

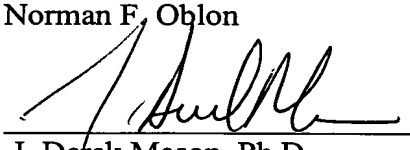
Applicants provide herewith a Terminal Disclaimer over Emoto '462, thereby obviating that rejection. With the exception of the provisional rejection, the remaining rejections have been overcome by the amendment of the claims to include the limitations of claim 9, requiring the toner particles to be spindle shaped. As noted by the Examiner, the references used in these other obviousness type double patenting rejections do not disclose or suggest such toner particles (also evidenced by the absence of claim 9 in each of these other rejections). As such, these rejections are also overcome by the present amendments.

The only remaining rejection is the provisional rejection over the copending '026 application. However, since this would be the only remaining rejection in the present application, the Examiner is requested to follow the procedures set forth in the MPEP and permit the present application to proceed to allowance/issue, and make any such rejection in the copending case as appropriate.

Applicants submit that the application is now in condition for allowance and early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



J. Derek Mason, Ph.D.
Attorney of Record
Registration No. 35,270

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)